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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/767,110 | 01/21/2001 | Scott G. Hicks | 000870 | 9091 |

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| EXAMINER |
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DENNISON, JERRY B

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| ART UNIT | PAPER NUMBER |
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2143

DATE MAILED: 06/04/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/767,110

Examiner

J. Bret Dennison

Applicant(s)

HICKS, SCOTT G.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 15-17 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 6, 12-14, 18 and 25-27 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This Action is in response to Application Number 09/767110 received on 21 January 2001.
2. Claims 1-27 are presented for examination.

Claim Objections

Claims 9, 10, 22, and 23 are objected to because of the following informalities: Claims 9, 10, 22, and 23 recite the limitation "another ADN record". Examiner will interpret this limitation as "a second And record." Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helle (U.S. Patent Number 6,694,152) in view of what is obvious.

3. Regarding claims 1 and 15, Helle discloses a method of storing; an e-mail address within an Abbreviated Dialing Number (ADN) record of a Subscriber Identity Module (SIM) card, the ADN record storing subscriber-specific contact information relating to subscriber contacts and including a Dialing Number field having a first number of bytes of memory space for typically storing a phone number associated with

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a subscriber contact and an Alpha Identifier field having a second number of bytes of memory space for typically storing a subscriber-defined alphanumeric tag associated with the subscriber contact.

Helle discloses storing in memory of the subscriber identity module a subscriber identifier (Helle, col. 3, lines 10-14) in an abbreviated dialing number directory (Helle, col. 2, lines 5-7), wherein a subscriber identifier includes an electronic mail address (Helle, col. 1, lines 25-30).

Although Helle does not explicitly state setting a flag in the ADN record indicating a presence of an e-mail address in the Alpha Identifier field, Helle teaches a subscriber identifier being conceived as subscriber identifiers for electronic mail addresses (Helle, col. 1, lines 25-30).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate a flag field into Helle to indicate the presence of an email address of the contact to benefit users by making it easier to find the required connection data, even among large amounts of stored connection identifiers (Helle, col. 2, lines 42-49).

4. Regarding claim 3, Helle, in view of obviousness, teaches the limitations of claim 1, including wherein the first field in the ADN record comprises an Alpha Identifier field (Helle, col. 1, lines 25-30, col. 3, lines 9-15, Helle teaches email addresses included in the subscriber identifier, an email address obviously containing alphanumeric symbols).

Claims 2, 4, 5, 7-11 and 16, 17, 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helle in view of Volland et al. (U.S. Patent Number 6,484,039).

5. Regarding claims 2 and 19, Helle, in view of obviousness, teaches the limitations of claims 1 and 15. However, Helle does not teach wherein the second number of bytes of memory space in the Alpha Identifier field is equal to or less than 241 bytes.

In an analogous art of storing contact information in a Subscriber Identity Module, Volland teaches with data records containing less than 241 bytes (Volland, col. 4, lines 5-15).

Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to combine Helle with Volland to provide a SIM card with directory entries for mobile telephones using a data structure that permits a hierarchical directory (Vollans, col. 1, lines 44-50) for the benefit of overcoming problems arisen when the card is switched to other telephones (Volland, col. 1, lines 34-39).

6. Regarding claims 4 and 16, Helle, in view of obviousness, teaches the limitations of claims 1 and 15. However, Helle does not teach wherein the ADN record further includes a Type of Number/Numbering Plan Identification (TON/NPI) field, and wherein the flag setting step comprises setting a flag in the TON/NPI field indicating a presence of an e-mail address in the Alpha Identifier field.

In an analogous art of storing contact information in a Subscriber Identity Module, Volland teaches extension data records for ADN records, wherein the extension data

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records include an identifier sector having an identifier for identifying a respective extension data record (Volland, col. 1, line 65 through col. 2, line 2).

See motivation for claims 2 and 19.

7. Regarding claims 5 and 17, Helle and Volland teach the limitations, substantially as claimed, as described in claims 4 and 16, including wherein the flag set in the TON/NPI field indicating the presence of an e-mail address in the Alpha Identifier field is set in an NPI portion of the TON/NP1 field (Volland, col. 2, lines 30-45).

8. Regarding claims 7 and 20, Helle and Volland teach the limitations, substantially as claimed, as described in claims 1 and 15, including wherein the ADN record includes a third field for storing a dialing number associated with the contact, and wherein the method further comprises the step of coding the third field in the ADN record as unused (Volland, col. 3, lines 25-40, Figure 1).

9. Regarding claims 8 and 21, Helle, in view of obviousness, teaches the limitations of claims 1 and 15. However, Helle does not teach wherein the ADN record includes a third field for storing a dialing number associated with the contact, and wherein the method further comprises the step of storing an invalid phone number in the third field in the ADN record. In an analogous art, Volland teaches extension data records for storing telephone entries, wherein an invalid phone number is a telephone entry (Volland, col. 2, lines 3-13).

10. Regarding claims 9 and 22, Helle, in view of obviousness, teaches the limitations of claims 1 and 15. However, Helle does not teach wherein the method further, comprises the step of allocating a first byte in the first field in the ADN record for identifying another ADN record containing a phone number for the contact. In an analogous art, Volland teaches an identifier sector for an extension record containing a phone number (Volland, col. 2, lines 30-45).

11. Regarding claims 10 and 23, Helle and Volland teach the limitations, substantially as claimed, as described in claims 9 and 22 including wherein the another ADN network further includes a subscriber-defined alphanumeric tag associated with the particular subscriber contact (Volland, col. 3, lines 25-40).

12. Regarding claims 11 and 24, Helle and Volland teach the limitations, substantially as claimed, as described in claims 1 and 15, including wherein the method further comprises the step of allocating a second byte in the first field in the ADN record for identifying an extension record containing a remaining portion of the e-mail address if the first number of bytes of memory space allocated to the first field in the ADN record is insufficient to store the e-mail address (Volland, col. 3, line 60 through col. 4, line 15, Volland teaches a SIM card where extension data records are used where a data record has an identifier that refers to a first extension data record).

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Allowable Subject Matter

Claims 6, 12-14, 18, and 25-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (703) 305-8756. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Bret Dennison
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